

Applicants: Mangin et al.

Application No.: 10/696,845

Amendment Accompanying a Request for Continued Examination dated April 30, 2009

Attorney Docket No.: 792-114 RCE II

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### **REMARKS**

Reconsideration of the present application is respectfully requested in view of the amendments and remarks herein.

#### **Discussion of the Claim Amendments**

Independent claims 1, 23, and 30 have been amended to recite that the light which leaves the visual marker includes light having a wavelength defining a first color within the visible spectrum of the naked eye of the operator, to recite that the light which leaves the means for releasably securing includes light having a wavelength defining a second color within the visible spectrum of the naked eye of the operator, and to recite that the visual marker permits the placement of the prosthesis without the need of fluoroscopy. Moreover, new claim 39 has been added. Support for the amendments to claims may be found in the application as originally filed at page 5, lines 1-9 and 14-17, page 7, line 31 to page 8, line 7, page 9, lines 10-14, and at page 11, lines 6-8 and 20-23.

#### **Response to the Rejection under 35 U.S.C. §103(a) in View of Strecker and DiCaprio**

Claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,653,748 (Strecker) in view of U.S. Patent Application Publication No. US 2003/0121148 (DiCaprio). Applicants respectfully traverse the rejection for the reasons set forth below.

In an effort to advance prosecution and not in acquiescence of the rejection, independent claims 1, 23, and 30 have been amended herein. Strecker and DiCaprio, alone or in combination, fail to disclose or suggest an apparatus including, *inter alia*, (i) a visual marker wherein the visual marker has an outer surface from which light, including light having a wavelength

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defining a first color within the visible spectrum of the naked eye of the operator, leaves and (ii) a means for releasably securing having an outer surface from which light, including light including a wavelength defining a second color within the visible spectrum of the naked eye of the operator leaves, wherein the visual marker permits the placement of the prosthesis without the need of fluoroscopy as required by all of claims 1-4, 8-14, 23, 26, 27, 30, 33, and 35 as presented herein.

Thus, claims 1-4, 8-14, 23, 26, 27, 30, 33, and 35 are patentably distinct over Strecker and DiCaprio, alone or in combination. Therefore, reconsideration and withdrawal of the rejection of claims 1-4, 8-14, 23, 26, 27, 30, 33, and 35 is respectfully requested.

**Response to the Rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Ravenscroft**

Claims 9-11 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 in further view of U.S. Patent No. 5,480,423 (Ravenscroft). Reconsideration is respectfully requested in view of the remarks and amendments herein.

Claim 9 depends from claim 1. Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 1 for the reasons discussed above. As such, Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 9 for the same reasons discussed with respect to claim 1. Indeed, there is no disclosure or suggestion in Strecker and DiCaprio of the subject matter of claim 9.

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Moreover, Ravenscroft fails to disclose or suggest the subject matter of claim 9 as presented herein. As such, Ravenscroft fails to overcome the deficiencies of Strecker and DiCaprio.

In view of the foregoing, claims 9-11 are not obvious in view of the cited combination of Strecker, DiCaprio, and Ravenscroft. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Ravenscroft.

**Response to the Rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio and Fischell**

Claims 36-38 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Strecker as modified by DiCaprio as applied to claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, and 35 in further view of U.S. Patent No. 5,792,144 to Fischell et al. (Fischell). Reconsideration is respectfully requested in view of the remarks and amendments herein.

Claims 36-38 all depend from claim 1, either directly or indirectly. Strecker and DiCaprio fail to disclose or suggest the subject matter of claim 1 for the reasons discussed above. As such, Strecker and DiCaprio fail to disclose or suggest the subject matter of claims 36-38 for the same reasons discussed with respect to claim 1. Indeed, there is no disclosure or suggestion in Strecker and DiCaprio of the subject matter of claims 36-38.

Moreover, Fischell fails to disclose or suggest the subject matter of claims 36-38 as presented herein. As such, Fischell fails to overcome the deficiencies of Strecker and DiCaprio.

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In view of the foregoing, claims 36-38 are not obvious in view of the cited combination of Strecker, DiCaprio, and Fischell. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) in view of Strecker, DiCaprio, and Fischell.

**Concluding Remarks**

The Commissioner is hereby authorized to charge any fees or to credit any overpayment to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Favorable action is earnestly solicited. If there are any questions, or if additional information is required, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,



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